

REMARKS

Reconsideration of the above-identified patent application, as amended, is respectfully requested.

Applicants acknowledge with appreciation the allowance of claims 12-17, 19 and 21. In reviewing the allowed claims, applicants' noticed that although claims 19 and 21 depend from method claim 11, claims 19 and 21 improperly recite a "system." Claims 19 and 21 are accordingly amended herein to properly recite a "method." No new matter has been introduced by these amendments. Applicants have not made these amendments for reasons related to the patentability of these claims, but have instead made these amendments to correct a clerical error.

Claims 1-11 stand rejected under 35 U.S.C. § 102(b) and (e) for the same reasons set forth in the previous Office Action. In response to the previous Office Action, applicants explained how none of the cited references anticipate applicants' claims because none show or disclose each and every claim element. In this Office Action, the Examiner did not address applicants' remarks, and instead stated only that there is insufficient structure recited in various ones of claims 1-11 to define over the disclosure set forth in certain figures of each of the cited references.

It appears that the Examiner is unwilling to consider the operational elements of the control computer recited in applicants' claim 1 as including structural features. This, however, is contrary to well-established case law. For example, *In re Bernhart and Fetter*, 163 USPQ 611, 615 (CCPA 1969) involved a computer-related invention wherein the Examiner rejected apparatus claims on the basis that the programmed computer did not define structural differences over cited prior art. This appears to be

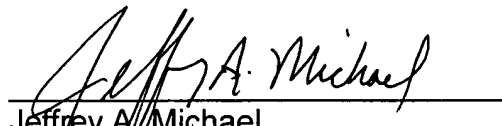
the same rationale used by the Examiner in the present case in rejecting applicants' claims 1-11. The *Bernhart* court reversed the Examiner's rejection and stated "if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program." *Id.* at 616. Physical difference is, of course, a structural difference. This passage was quoted with approval by the Federal Circuit in *In re Lowry* 32 USPQ2d 1031 (Fed. Cir. 1994). The *Lowry* court further stated that "data structures are specific electrical or magnetic structural elements." It is thus well-established that claim limitations reciting data structures and/or operational aspects of programmed computers constitute structural claim elements. As such, they cannot be ignored in apparatus claims.

It is well-understood by persons of ordinary skill that a computer can only perform operations in accordance with instructions provided to the computer, such as in the form of one or more software programs. Applicants' claim 1 recites operations performed by a computer as a result of such instructions, and the recited operations thus constitute structural limitations. Moreover, applicants' claim 1 recites the computer "determining a maximum compressor outlet pressure value . . .", wherein the maximum compressor outlet pressure value is a specific electrical structure within the meaning of "data structure" as set forth by the *Lowry* court. Additionally, applicants' claim 1 recites the computer "controlling the control mechanism in a manner that limits compressor outlet pressure to the maximum outlet pressure . . ." This limitation requires physical control of a structural element external to the computer, and is therefore clearly a structural limitation.

Applicants have, in their response to the previous Office Action, explained that none of the cited references disclose each and every element of applicants' claims 1-11. For example, none of the references describe controlling any one or more actuators, based on information provided by any one or more sensors or any other information, in a manner that limits the compressor outlet pressure to the maximum compressor outlet pressure to thereby limit rotational speed of the turbocharger to the maximum turbocharger speed value as required by applicants' independent claim 1. As explained herein, the claim language following "a control computer . . ." includes structural limitations that the Examiner must take into account. It is applicants' position that when the Examiner properly does so, none of the cited references will be found to anticipate applicants' claims 1-11 as applicants' explained in their response to the previous Office Action.

Applicants have traversed all grounds of rejection, and respectfully request withdrawal of the § 102(b) and (e) rejections of applicants' claims 1-11. Claims 1-11, 12-17, 19 and 21 are believed to be in condition for allowance, and such action is solicited. The Examiner is cordially invited to contact the undersigned by telephone to discuss any unresolved matters.

Respectfully submitted,


Jeffrey A. Michael
Registration No. 37,394
Barnes & Thornburg
14 South Meridian Street
Indianapolis, Indiana 46204-3335
Telephone: (317) 231-7382
Fax: (317) 231-7433